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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT PAPER NUMBER

2614

DATE MAILED: 03/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/769,157

Applicant(s)

CLAPPER, EDWARD O.

Examiner

Melur Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20, 57-60 and 70-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20, 57-60, 70-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Specification

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C 112 first paragraph as failing to provide an enabling disclosure.

Claim Rejections - 35 USC § 112

2. Claims 1-20, 57-60, 70-75, 76-84 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Independent claim 1 recites the limitation: searching in the stream storage for an instance of a clip from a first portion of the media stream, the clip captured at random before said searching and stored in a clip storage unit, and if the clip is found, storing in another storage the first portion of the media stream from an identified start of the first portion and including the clip, otherwise if the clip is not found discarding some portion of the searched media stream. Regarding this, specification does not have adequate disclosure as to how clip is found other than saying Well-known digital signal processing techniques are equipped to identify matches within a predetermined or controllable level of likelihood or tolerance. This is hardly enough disclosure for finding matches between the stored clip and newly incoming media stream. Second specification does not

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discloses how to do: "storing in a another storage unit the first portion of the media stream from an identified start of the first portion and including the clip. Specification does not disclose how this is accomplished. For example, the claim says the clip is captured at random. As an example, say, the clip is captured at the middle of the song for certain length of time and stored when the song is first broadcast. When the song is again re-broadcast, the incoming song is compared to stored clip for determining whether there is match or not between the incoming song and stored clip of song. This process would take finite amount of time. Then identifying the start of the first portion of the clip takes some more time. By this time rebroadcast of song would have progressed more and the specification does not discloses any mechanism how it can identify start point of stored clip after finding a match with the stored clip and still store the song including the clip in question. Under these circumstances, specification does not explain, how this limitation is implemented, viz: searching in the stream storage for an instance of a clip from a first portion of the media stream, the clip captured at random before said searching and stored in a clip storage unit, and if the clip is found, storing in another storage the first portion of the media stream from an identified start of the first portion and including the clip, otherwise if the clip is not found discarding some portion of the searched media stream. Regarding this, although applicant stated, in his response office action dated 10-24-2005, on page 8 of his response that "The receiving and storing may be on going, Page 5, lines 7-8. Applicant further refers to various possibilities such as "the user may estimate the time into block that a trigger was hit. Thus it is submitted that with the knowledge that some time has passed between clip

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capture and the start of the block, a stream would be stored for a long enough time and/or window would be large enough to enable finding the clip identifying the beginning of the block". Applicant further refers to abstract of his invention and says that "in the abstract it is recognized that the clip may be taken from the middle of the song or show and then upon finding the clip, the beginning of the song or show would be identified so that entire song or show could be saved". Applicant further refers to refers to original claim 50 in support of enablement of his invention. Finally applicant concludes that "in sum it is respectfully submitted that the disclosure is enabling in each of the areas that the examiner is concerned about. Namely, there is adequate disclosure for how a clip may be found, how a start point can be identified, and the time factors involved with identifying the clip and finding the identified start of the first portion". None of applicants explanation and various references that he has made to the specification addresses the time factors involved in the scenario given above: As an example, say, the clip is captured at the middle of the song for certain length of time and stored when the song is first broadcast. When the song is again re-broadcast, the incoming song is compared to stored clip for determining whether there is match or not between the incoming song and stored clip of song. This process would take finite amount of time. Then identifying the start of the first portion of the clip takes some more time. By this time rebroadcast of song would have progressed more and the specification does not disclose any mechanism how it can identify start point of stored clip after finding a match with the stored clip and still store the song including the clip in question. Under these circumstances, specification does not explain, how this limitation

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is implemented, viz: searching in the stream storage for an instance of a clip from a first portion of the media stream, the clip captured at random before said searching and stored in a clip storage unit, and if the clip is found, storing in another storage the first portion of the media stream from an identified start of the first portion and including the clip, otherwise if the clip is not found discarding some portion of the searched media stream.

Claim 70 also has a similar discrepancy as claim 1 mentioned above.

Independent claims 14, 70 and newly added 76 have similar limitations.

Therefore, rejection of claims 1-20, 57-60, 70-75, 76-84 under 112 first paragraph is maintained.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4, 6, 8-11, 14-15, 17-18, 20, 57, 60, 70-72, 76-77, 82-84, are rejected under 35 U.S.C 102(b) as being anticipated by Nishiuchi (JP 05-089558).

Regarding claim 1, Nishiuchi discloses a method comprising: receiving a media stream to store the media stream in a storage unit (4, Drawing 1), searching the stored media stream for a clip of a first portion of the media stream, the clip previously stored at random and stored in a storage unit and when clip is found, storing in a storage unit (6, drawing 1) the first portion of the media stream from the identified start of the first

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portion and including the clip, otherwise when the clip is not found discarding some of the searched media stream (paragraphs: 0001, 0005, 0006-0009).

Regarding claim 14, Nishiuchi discloses an apparatus comprising: a receiver (1, Drawing 1) to receive a media stream, capture trigger to designate a clip of the media stream, a storage system (4, Drawing 1) coupled to the receiver to store the clip, the media stream, and a block of media stream, and processing system (8, Drawing 1) coupled to the storage system to search for the clip in the stored media stream after storage of the clip, and in response to finding the clip, identify a start point of the block including the clip, and store the block from the start (paragraphs: 0001, 0005, 0006-0009).

Regarding claim 70, Nishiuchi further teaches an article comprising machine readable storage medium containing instructions that if executed enable a system to: receive a media stream to store the media stream in a storage unit (4, Drawing 1), search the stored media stream for a clip of a first portion of the media stream, the clip previously captured at random and stored in a storage unit, and when the clip is found, store in a storage unit (6, Drawing 1) the first portion of the media stream from the identified start of the first portion and including the clip, otherwise when the clip is not found discarding some of the searched media stream (paragraphs: 0001, 0005, 0006-0009).

Regarding claim 76, Nishiuchi discloses a method comprising: capturing an arbitrary clip of media stream at one time, at a latter time, finding the clip in the media

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stream, and in response to finding, identifying a start of a block of content that includes the clip to store the block from the start (paragraphs: 0001, 0005, 0006-0009).

Regarding claims 2-4, 6, 8-11, 15, 17-18, 20, 57, 60, , 71-72, Nishiuchi further teaches the following: performing digital signal processing upon a window of the media stream to produce digital signal processing window result, comparing the digital signal processing window result to the digital signal processing clip result (paragraphs: 0006-0007), identifying the start point of the first portion and an end portion of the first portion from the media stream, and storing the first portion of the media stream from the start point to the end point, again finding the clip in the media stream, and storing another portion of the media stream greater than and including clip, media stream comprises audio, media stream comprises video, media stream comprises television, receiving parameters, and wherein at least one of finding and storing are responsive to parameters, parameters comprise at least one of: an estimated time into the first portion that a trigger was activated, a length of possible block to watch, etc (Drawings: 1-3, paragraphs: 0005-0009), a block manager in (8, Drawing: 1) to store a block of media stream to storage system, the clip is a subset of the block, the receiver is coupled to receive the media stream over a wireless broadcast channel, an output device (6, Drawing: 1) coupled to the receiver to play the media stream, processing system comprises a block manager in (8, Drawing: 1), the block manager containing instructions that, if executed enable the processor to locate two blocks in the media stream, the block including the clip, storage comprises a clip storage (4, Drawing: 4) to store the clip, block storage (6, Drawing: 1) to store one or more blocks, stream storage

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(6) to store media stream, finding one or more blocks includes identifying the clip in the media stream, storing one or more blocks, strong one or more blocks includes identifying a start point and end point of a given block in the media stream, and strong the media stream from the start point to the end point, during play of a particular block after start of the particular block, receiving a signal to record the clip (Drawings: 1-3, paragraphs: 0005-0009).

Regarding claims 77, 82-84, Nishiuchi further teaches the following: finding the clip in the media stream at another time, and storing another block of content from the start of another block, finding the clip includes performing digital signal processing (reads on distinction section 5, Drawing 1) upon stored media stream and upon the clip to produce processing results, and comparing the processing results for media stream and the clip, discarding a portion of the searched media stream in which clip is not found, media stream comprises television (Drawings: 1-3, paragraphs: 0005-0009).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 58-59, 73, 78-79, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiuchi in view of Honma (JP 2000-312323).

Regarding claims 5, 58, 73, 78-79, Nishiuchi does not teach the following: comparing the first portion to other portion, and discarding one of the portions, based on comparison, enable the block manager to compare a first block and a second block, and to discard one of the blocks, based on comparison selecting a better of the blocks, discarding the block that was not selected, instructions to enable the system to compare the first portion, and discard one of the portions based on the comparison.

However, Honma discloses a program reservation video recording apparatus which teaches the following: comparing the first portion to other portion, and discarding one of the portions, based on comparison, enable the block manager to compare a first block and a second block, and to discard one of the blocks, based on comparison selecting a better of the blocks, discarding the block that was not selected, instructions to enable the system to compare the first portion, and discard one of the portions based on the comparison (Drawing: 4, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: comparing the first portion to other portion, and discarding one of the portions, based on comparison, enable the block manager to compare a first block and a second block, and to discard one of the blocks, based on comparison selecting a better of the blocks, discarding the block that was not selected, instructions to enable the system to compare the first portion, and discard one of the portions based on the comparison as this arrangement would facilitate the user to discard the unsatisfactory recording of the data and retain the good recording for his use as taught by Honma.

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Regarding claim 59, Nishiuchi teaches the following: instructions to enable the block manager to discard a portion of the media stream that does not include the clip (see abstract).

7. Claims 7 and 16, are rejected under 35 U.S.C. 103(a) as being unpatentable over in view of Matsumoto (JP 410055656A).

Regarding claims 7 and 16, Nishiuchi does not teach the following: audio comprises broadcast radio, media stream comprises a radio block and the block comprises a song.

However, Matsumoto discloses received information-recording system, which teaches the following: audio comprises broadcast radio, and media stream comprises a radio block and the block comprises a song (fig. 1, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: audio comprises broadcast radio and media stream comprises a radio block and the block comprises a song as this arrangement would enable the users to record radio programs as taught by Matsumoto.

8. Claims 12-13, 74-75, 80-81, are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiuchi in view of Hasegawa et al. (US PAT: 6,570,080, filed 5-18-2000, hereinafter Hasegawa).

Regarding claims 12-13, 74-75, 80-81, Nishiuchi does not teach the following: identifying the media content item corresponding to the clip, and obtaining the media content from a source which is different than the media stream, source is an on-line

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retailer, identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer.

However, Hasegawa discloses method and system for supplying contents via communication network which teaches the following: identifying the media content item corresponding to the clip, and obtaining the media content from a source which is different than the media stream, source is an on-line retailer, identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer (col. 2 lines 38-67, col. 3 lines 1-53).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: identifying the media content item corresponding to the clip, and obtaining the media content from a source which is different than the media stream, source is an on-line retailer, identifying the block corresponding to the clip and obtaining the block from a source which different than the media stream, obtaining the block from a on-line retailer as this arrangement would facilitate the user to obtain media content from the alternate sources as taught by Hasegawa, thereby providing user with choices.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiuchi in view of Perlman (US PAT: 6,125,259).

Regarding claim 19, Nishiuchi does not teach the following: the receiver is coupled to receive the media stream over a wired broadcast channel.

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However, Perlman discloses intelligent and user friendly channel up/down control which teaches the following: the receiver is coupled to receive the media stream over a wired broadcast channel (col. 4 lines 43-61).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Nishiuchi's system to provide for the following: the receiver is coupled to receive the media stream over a wired broadcast channel as this arrangement would provide another well known system to receive media stream as taught by Perlman.

Response to Arguments

10. Applicant's arguments filed on 1-24-2006 have been fully considered but they are not persuasive.

Rejection of independent claims 1, 14, 70, and 76 under 35 U.S.C 102(b) as being anticipated by Nishiuchi (JP 05-089558): Regarding rejection of the claims using the above reference, Applicant argues that "there is no evidence that Nishiuchi stores an incoming media stream in such a way that if a clip is found in a stored media stream, the start of a first portion of the media stream can be identified so that a the first portion may be stored in another distinct storage. Simply, as best described in Nishiuchi's abstract, when a sound signal of a television broadcast ... Nishiuchi does not describe discrimination part 5 as a memory or having memory capabilities. Therefore, after comparison with data read out from the memory part 4, the inputted signal to be discrimination part is lost". Regarding this, distinction section (5, drawing 1) is

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comparing the incoming audio or video with stored audio or video imply that distinction section (5, drawing 1) has to buffer incoming audio or video so that it can be compared thus implying distinction section (5, drawing 1) has buffering capability or memory capability (paragraphs: 0007-0008). Applicant further argues that "Typically the videocassette recorder format is analog and Nishiuchi does not indicate otherwise. Thus, if theme music of a program is broadcast, it is first recognized in the discrimination unit 5 and before analog recording takes place. If recording has been previously stopped due to lack of agreement, restart of videotape recording would be after the beginning of the program. There is no indication that Nishiuchi does otherwise". Regarding this note that Nishiuchi teaches recording of audio (like theme song) from the beginning in the sense that the theme song is recorded at the beginning of the video tape and used for comparison purpose by the discrimination unit 5 and if a match is found between the stored and compared audio (like theme song), VTR has recording from the beginning to the end of the program (0007-0008). Applicant further argues that "Additionally, as was previously explained in earlier responses, Nishiuchi is limited to the recognition of the beginning of a program. Moreover, as explained above, Nishiuchi does not provide a mechanism store a program from the beginning of the program after the beginning of the program is started". Regarding this, as explained above, Nishiuchi teaches recording of the beginning of the audio (for example theme song) in a VTR (6) and used for comparison in discrimination unit 5 to find a match, if a match found, VTR (6) has recording from the beginning to the end of the program (0007-0008).

In light of this explanation, rejection of claims 1-20, 57-60, 70-84 is maintained.

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

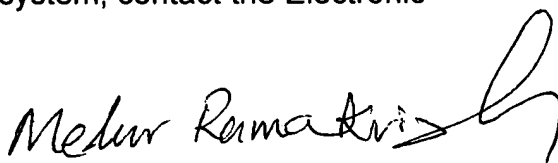
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melur Ramakrishnaiah
Primary Examiner
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